

### REMARKS

This paper responds to the Office Action mailed on July 28, 2005. Claims 6-16 and 29-36 are now pending in this application.

#### §103 Rejection of the Claims

Claims 6-16 and 29-36 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Sabin (US 6,099,555) in view of Avery (US 5,486,206). Applicant respectfully submits that a *prima facie* case of obviousness has not been established because (i) Sabin and Avery do not disclose either singularly, or in combination, the invention as claimed in claims 6-16 and 29-36; (ii) the Examiner has not provided an adequate motivation to combine Sabin and Avery; and (iii) Avery teaches away from any combination with Sabin.

#### Sabin

Sabin is directed to a cold pack that includes a gelling agent which is adhered as a permeable coating to a particulate “cold generating” material (see, col. 1, lines 49-52 of Sabin). The combined gelling agent and cold particulate material are initially segregated from a liquid within the cold pack by a “single use” frangible membrane (see, col. 2, lines 1-11 of Sabin). The cooling function of the cold pack is begun by fracturing the membrane and mixing the liquid with the combined gelling agent and cold particulate material.

Sabin does not disclose “an absorbent core within said enclosure, said absorbent core being formed at least partially of a fibrous material that retains said endothermic solution within said enclosure to spread said endothermic solution throughout the interior of said enclosure” as recited in claims 6 and 12. Applicant respectfully notes that Sabin provides no teaching or suggestion as to an absorbent core that retains an endothermic solution because the cooling gel which is formed upon mixing in Sabin is actually the endothermic solution itself. Therefore, Sabin does not disclose an absorbent core that retains the endothermic solution as indicated by the Examiner because nothing in the enclosure retains the cooling gel to spread the cooling gel throughout the enclosure.

### **Avery**

Avery is directed to a “reusable” thermal pack that includes one or more pads which encapsulate a gel (see, col. 1, lines 53-57 of Avery). The gel in Avery includes a fibrous, flaked or shredded material (see, col. 2, lines 1-2 of Avery).

Avery does not disclose “an absorbent core within said enclosure, said absorbent core being formed at least partially of a fibrous material that retains said endothermic solution within said enclosure to spread said endothermic solution throughout the interior of said enclosure” as recited in claims 6 and 12. Applicant respectfully notes that fibrous material disclosed in Avery does not retain an endothermic solution to spread the endothermic solution. In addition, the drawings in Avery illustrate that the fibers in Avery are not part of any type of structure (i.e., like a “core”) such that Avery does not disclose an absorbent core.

### **I. The Combination of Sabin and Avery Does Not Teach Every Element of Claims 1, 3-5 and 9-15**

The references must teach or suggest all the claim elements. M.P.E.P. § 2142 (citing *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed.Cir. 1991)). As discussed above, neither reference teaches or suggests either singularly, or in combination, “an absorbent core within said enclosure, said absorbent core being formed at least partially of a fibrous material that retains said endothermic solution within said enclosure to spread said endothermic solution throughout the interior of said enclosure” as recited in claims 6 and 12. Applicant again respectfully submits that Sabin and/or Avery do not teach or suggest an absorbent core, especially an absorbent core that retains an endothermic solution.

### **II. There is No Motivation or Suggestion to Combine Sabin and Avery**

The Office Action must provide specific, objective evidence of record for a finding of a suggestion or motivation to combine reference teachings and must explain the reasoning by which the evidence is deemed to support such a finding. *In re Sang Su Lee*, 277 F.3d 1338, 61 U.S.P.Q.2D 1430 (Fed. Cir. 2002). The Final Office Action states at page 4 that “it would have been obvious to one having ordinary skill in the art to modify the invention of Sabin, as taught

by Avery, to provide the gel with a fibrous material in order to increase gel viscosity and heat capacity.”

Applicant respectfully submits that this is a mere conclusory statement of subjective belief because the statement is similar to the statements made by the Examiner and board in *In re Lee*, 277 F.3d 1338 (Fed. Cir. 2002).

“With respect to Lee’s application, neither the examiner nor the Board adequately supported the selection and combination of the Nortrup and Thunderchopper references to render obvious that which Lee described. The examiner’s conclusory statements that ‘the demonstration mode is just a programmable feature which can be used in many different devices for providing automatic introduction by adding the proper programming software’ and that ‘another motivation would be that the automatic demonstration mode is user friendly and it functions as tutorial’ do not adequately address the issue of motivation to combine. This factual question of motivation is material to patentability, and could not be resolved on subjective belief and unknown authority. It is improper, in determining whether a person of ordinary skill in the art would have been lead to this combination of references, simply to use ‘[use] that which the inventor taught against its teacher.’ *W.L. Gore V. Garlock, Inc.*, 721 F. 2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983).” *Lee*, at 1343, 1344.

Applicant respectfully submits that the only teaching or suggestion relating to “an absorbent core within said enclosure, said absorbent core being formed at least partially of a fibrous material that retains said endothermic solution within said enclosure to spread said endothermic solution throughout the interior of said enclosure” as recited in claims 6 and 12 is found in Applicant’s disclosure. Applicant respectfully notes that the Office Action has not provided objective evidence that there is an adequate motivation to combine the references.

### **III. Avery teaches away from any combination with Sabin**

A factor cutting against a finding of motivation to combine or modify the prior art is when the prior art teaches away from the claimed combination. A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path the applicant took. *In re Gurley*, 27 F.3d 551, 31 USPQ 2d 1130, 1131 (Fed. Cir. 1994); *United States v. Adams*, 383 U.S. 39, 52, 148 USPQ 479, 484 (1966); *In re Spinnoble*, 405 F.2d 578,

587, 160 USPQ 237, 244 (C.C.P.A. 1969); *In re Caldwell*, 319 F.2d 254, 256, 138 USPQ 243, 245 (C.C.P.A. 1963).

Applicant respectfully notes that Avery teaches away from any combination with Sabin because Avery teaches a “reusable” thermal pack (see Avery at col. 1, lines 53 and 56). In contrast, Sabin relates to a one-time use cold pack where the liquid and the cold particulate material are initially segregated and then mixed together to start the endothermic reaction. Once the liquid and the cold particulate material are mixed together, the endothermic chemical reaction can not be carried out again. Applicant respectfully submits that based on the reusable thermal pack teachings of Avery, one of ordinary skill in the art would look away from the one-time use device that is disclosed in Sabin.

#### **IV. Conclusion**

The §103(a) rejection failed to make a *prima facie* case of obviousness against claims 6-16 and 29-36. Reconsideration and allowance of claims 6-16 and 29-36 are respectfully requested.

**CONCLUSION**

Applicant respectfully submits that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney (262) 646-7009 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

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**CERTIFICATE UNDER 37 CFR 1.8:** The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Mail Stop AF, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 12 day of September, 2005.

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